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In re Application of :
Kovesdi and Rajasekharan :
Application No. 10/035,952 : DECISION DISMISSING PETITION
Filed: 26 December, 2001 :
Attorney Docket No. 66566.01US2 :

This is a decision on the petition filed on 19 April, 2004, which is treated as a renewed petition under 37 CFR 1.182.

The petition is **DISMISSED**.

On 26 December, 2001, the above-identified application was filed. Papers filed on 23 August, 2002, in response to the Decision Under 37 CFR 1.47(a) and 1.182 mailed on 16 August, 2002, included a Declaration signed by the previously non-signing inventor, Rajasekharan, in compliance with 37 CFR 1.63.

A petition under 37 CFR 1.182 requesting that all correspondence be required to be signed by representatives of both joint inventors was filed on 23 August, 2002, and was granted on 17 September, 2002.

In the present renewed petition, petitioner Kovesdi argues that petitioner Rajasekharan has refused to sign a response to the outstanding Office action. Petitioner Kovesdi requests that the requirement that all correspondence be signed by representatives of both joint inventors be withdrawn so that Kovesdi may, by herself, file a response to the Office action. Petitioners also request that the petition under 37 CFR 1.47(a) be granted. Petitioners' arguments have been carefully considered, but are not persuasive that the relief can or should, be granted.

At the outset, it is noted that the petition under 37 CFR 1.47(a) originally filed on 13 May, 2002, was dismissed as moot on 17 September, 2002, because both joint inventors have signed the declaration in compliance with 37 CFR 1.63. As such, Rule 47 status is not applicable to the present application.

Petitioners' argument that Rule 47 status should be granted because Rajasekharan, after signing the declaration, refuses to cooperate in signing correspondence in the Office misinterprets the purpose of Rule 47.

With regard to the request that the requirement that correspondence be signed by representatives of both inventors be revoked, petitioners' argument has been considered, but is not persuasive. When a petition under 37 CFR 1.182 requiring the signature of representatives of more than one applicant on all correspondence is granted, petitioners assume the risk that not all of the applicants may cooperate in signing correspondence. To grant this petition would essentially render the grant of such a petition under 37 CFR 1.182 of no effect, as petitioner could by such means file Office correspondence upon behalf of the recalcitrant inventor, to the prejudice of that inventor's rights. It is noted that the general policy of the USPTO is that the owner of less than the entire interest of a given application will not be permitted to unilaterally control prosecution unless and until it is clearly shown that the rights of that party are being prejudiced by the action(s) or inaction(s) of the party(s) that constitute(s) the remaining interest. Nevertheless the mission of the USPTO is to accept and examine applications for patent that ultimately promote the progress of science and the useful arts, and a party constituting less than the entire interest who nevertheless seeks to bring an invention before the public will not, ultimately be thwarted in that endeavor.

Petitioner Kovesdi may wish to consider filing a continuation or divisional application covering only the matter invented by her, naming herself as the sole inventor. In doing so, petitioner Kovesdi may prosecute the application without the necessity of obtaining the cooperation of Rajasekharan. Should petitioner wish to prosecute claims to the jointly invented subject matter as well, then petitioner may wish to consider filing a continuing application and again seek relief under 37 CFR 1.47 if Rajasekharan does not execute the declaration. If however Rajasekharan does join in that application and again displays the recalcitrance herein complained of in failing to assisting in the prosecution of that application containing the joint claims, petitioner may re-present the instant petition under 37 CFR 1.182 and then seek the requested relief.

With regard to petitioner's request for suspension of action, 37 CFR 1.103(a) provides that:

On request of the applicant, the Office may grant a suspension of action by the Office ... for good and sufficient cause. The Office will not suspend action if a reply by the applicant to an Office action is outstanding. Any petition for suspension of action ... must specify a period of suspension not exceeding six months. Any petition for suspension of action ... must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) the fee set forth in \$1.17(h), unless such cause is the fault of the Office.

The above-identified application was filed on 26 December, 2001. On 16 December, 2003, the Office mailed applicant a non-final Office action. This action set a three-month shortened statutory period for reply, to 17 March, 2004, with requests for extensions of time under 37 CFR 1.136(a) permitted. A proper reply has yet to be received.

The petition must be dismissed as improper. Action cannot be suspended in an application awaiting a reply by the applicant.

Further, applicant is specifically advised that the original three-month period for reply has expired, but that period may be extended by a request for such accompanied by the appropriate fee for extension of time, and the reply itself. The time for submitting a proper reply cannot be extended **beyond 16 June, 2004** (with payment of a three-month extension of time fee). **Failure to timely file a proper reply (including the appropriate extension of time fee) will result in the abandonment of the application.**

Based on the foregoing, the petition is **dismissed**.

Counsel's deposit account, No. 50-3013, will be charged a fee of \$130.00 for consideration of the present petition.

Further correspondence may be addressed to the following:

By mail: Mail Stop Petition
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Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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¹Effective 5 June, 2004, street addresses for several of the buildings of the United States Patent and Trademark Office (USPTO), including the Crystal Plaza Two building which is the location of the Customer Window, have been changed. This change is made because the street on which the Crystal Plaza Two building is located will be redesignated from South Clark Place to 20th Street S.